

REMARKS

This Response is submitted in reply to the non-final Office Action mailed on May 5, 2006. No fee is due in connection with this Response. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-36 on the account statement.

Claims 1-16 are pending in this application. In the Office Action, Claims 1-2 and 6 are rejected under 35 U.S.C. §102 and Claims 1-16 are rejected under 35 U.S.C. §103. For the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1-2 and 6 are rejected under 35 U.S.C. §102(b) as anticipated by the product 100% Whey Protein 5 lbs by Optimum Nutrition ("*Optimum Nutrition*"). Applicants respectfully disagree with and traverse this rejection for at least the reasons set forth below.

Applicants respectfully submit that the Patent Office has failed to demonstrate that *Optimum Nutrition* was on sale before the priority date of the present application (i.e. March 31, 1998). Moreover, the Patent Office has failed to show that any earlier version of the product of *Optimum Nutrition* was identical to that now sold.

Accordingly, Applicants respectfully request that the rejection of Claims 1-2 and 6 under 35 U.S.C. §102(b) be withdrawn.

In the Office Action, Claims 1-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Optimum Nutrition* in view of U.S. Patent No. 5,849,335 to Ballevre et al. ("*Ballevre*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Applicants submit that one having ordinary skill in the art would not be motivated to combine *Optimum Nutrition* and *Ballevre* to arrive at the present claims. The whole premise of *Ballevre* is that carob protein is rich in glutamine and that its nutritional composition for improving plasma glutamine should include carob protein. *Ballevre* further teaches that its mixture of carob and whey proteins uses whey protein as the minor rather than the major component. See, *Ballevre*, column 4, lines 27-35; Example 2. For example, *Ballevre* discloses that carob protein comprises about 40% to about 100% by weight of the protein source of its

nutritional composition, which results in the protein source in *Balleve* containing a minimum of “about 40%” of the protein source of carob. Because *Balleve* teaches that it is essential to retain carob protein, it teaches away from a combination with *Optimum Nutrition* that is directed to a product comprising 100% whey proteins.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). This certainly applies here where one of the cited references is directed to a product that must comprise some and preferably a majority of carob protein (*Balleve*) and the other cited reference is directed to a product comprising only whey protein (*Optimum Nutrition*). The specific formulation for each product as taught by the cited references is important and specific to that particular product. Because of these differences, one skilled in the art would not be motivated to modify or combine *Optimum Nutrition* and *Balleve* to arrive at the present claims.

For at least the reasons discussed above, the combination of *Optimum Nutrition* in view of *Balleve* is improper, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1-16 be reconsidered and the rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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Dated: August 3, 2006